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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,899	09/28/2001	Vadim Borodovski	KNK-3.2.003/4107	3468
1059	7590	08/12/2004	EXAMINER	
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			BURGE, LONDRA C	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/965,899

Applicant(s)

BORODOVSKI ET AL.

Examiner

Londra C Burge

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/3/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: Original application filed 9/28/2001 and IDS filed 12/3/2003.
2. Claims 1-15 are pending. Claims 1, 7, 13 and 15 are independent claims.

### *Claim Rejections - 35 USC § 102*

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis U.S. Patent No. 5,794,259 filed 7/25/1995. (Provided by the applicant)**

**In regard to independent claim 1, Kikinis discloses *locating a data field in the document to be populated; associating a visual indication with the data field; providing a wallet capable of having a plurality of data fields; and, populating the data field in the document with data from a data field in the wallet.*** (Kikinis Col 2 Lines 8-20 i.e. (a) selecting a field in an Internet form; (b) invoking a display of tags associated with multiple stored fill entities; (c) selecting one of the tags in the display of tags, causing the fill entity associated with the tag to be entered in the selected field in the form; and (d) repeating steps (a) through (c) until all of the fields in the form are filled.)

**In regard to dependent claim 2,** Kikinis discloses *subsequent to populating the data field, determining if another data field exists that may be populated; locating the another data field to be populated; and, associating the visual indication with the another data field.* (Kikinis Col 2 Lines 8-20 i.e. (a) selecting a field in an Internet form; (b) invoking a display of tags associated with *multiple stored fill entities*; (c) selecting one of the tags in the display of tags, causing the fill entity associated with the tag to be entered in the selected field in the form)

**In regard to dependent claim 3,** Kikinis discloses *populating another data field with data from another data field in the wallet.* (Kikinis Col 2 Lines 8-20 i.e. (b) invoking a display of tags associated with multiple or different stored fill entities; (c) selecting one of the tags in the display of tags, causing the fill entity associated with the tag to be entered in the selected field in the form and Figure 2 shows different fields which would contain different data)

**In regard to dependent claim 4,** Kikinis discloses *associating another visual indication with the data field in the wallet.* (Kikinis Col 2 Lines 8-20 i.e. (b) invoking a display of tags associated with multiple or different stored fill entities; and Figure 2 shows different fields which would contain different data)

**In regard to dependent claim 5,** Kikinis discloses *placing one of an arrow, a star, a lightning bolt, a cursor and a dot next to the data field.* (Kikinis Col 4 Lines 5-25 i.e. the code could be provided so one may move the conventional screen cursor to a field and provide the activating signal by a hot key, displaying the bubble. Movement of the highlight bar could then be by further cursor movement, as in drop-down menus, or by arrow keys.)

**In regard to dependent claim 6,** Kikinis discloses *wherein said associating a visual indication includes highlighting the data field.* (Kikinis Col 4 Lines 5-25 i.e. the code could be provided so one may move the conventional screen cursor to a field and provide the activating signal by a hot key, displaying the bubble. Movement of the highlight bar could then be by further cursor movement, as in drop-down menus, or by arrow keys. Any one of a variety of mechanisms might be incorporated for selection of a highlighted item in the list, which then is inserted into the field to which the bubble points.)

**In regard to independent claim 7,** Claim 7 in addition to the following reflects similar subject matter claimed in claim 1 and is rejected along the same rationale. (Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to dependent claim 8,** Claim 8 in addition to the following reflects similar subject matter claimed in claim 2 and is rejected along the same rationale. (Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to dependent claim 9,** Claim 9 in addition to the following reflects similar subject matter claimed in claim 3 and is rejected along the same rationale. (Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to dependent claim 10,** Claim 10 in addition to the following reflects similar subject matter claimed in claim 4 and is rejected along the same rationale.

(Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to dependent claim 11**, Claim 11 in addition to the following reflects similar subject matter claimed in claim 5 and is rejected along the same rationale. (Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to dependent claim 12**, Claim 12 in addition to the following reflects similar subject matter claimed in claim 6 and is rejected along the same rationale. (Kikinis Col 1 Lines 59-67 and Col 2 Lines 1-7 i.e. apparatus arranged to make the method of filling out forms possible)

**In regard to independent claim 13**, Kikinis discloses *a wallet capable of having a plurality of data fields* (Kikinis Col 2 Lines 8-20 i.e. (a) selecting a field in an Internet form; (b) invoking a display of tags associated with multiple stored fill entities); *and, software capable of visually indicating the data field in the electronic document and of copying data from at least one data field in the wallet to the data field in the electronic document.* (Kikinis Col 6 Lines 20-30 i.e. (c) downloading a form as code from a server on the Internet through a browser using the computer; (d) associating the tags of the stored fill entities with coded field names in the code of the downloaded form; and (e) causing the stored fill entities with tags matching coded field names in the code of the downloaded form to be associated with the coded fields to which the tags match.)

**In regard to independent claim 14**, Kikinis discloses *wherein said software is further capable of locating another data field in the electronic document and indicating the another data field.* (Kikinis Col 2 Lines 8-20 i.e. (a) selecting a field in an Internet

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form; (b) invoking a display of tags associated with multiple stored fill entities; (c) selecting one of the tags in the display of tags, causing the fill entity associated with the tag to be entered in the selected field in the form; and (d) repeating steps (a) through (c) until all of the fields in the form are filled and Figure 2 shows different fields which would contain different data.) (Kikinis Col 6 Lines 20-30 i.e. (c) downloading a form as code from a server on the Internet through a browser using the computer; (d) associating the tags of the stored fill entities with coded field names in the code of the downloaded form; and (e) causing the stored fill entities with tags matching coded field names in the code of the downloaded form to be associated with the coded fields to which the tags match.)

**In regard to independent claim 15,** Kikinis discloses *populating at least one data field in a wallet with information; locating an empty data field in an electronic document; visually indicating the empty data field; selecting the at least one data field from the wallet; automatically populating the empty data field with the information from the at least one data field; locating another empty data field in the electronic document; and, visually indicating the another empty data field.* (Kikinis Col 2 Lines 8-20 i.e. (a) selecting a field in an Internet form; (b) invoking a display of tags associated with multiple stored fill entities; (c) selecting one of the tags in the display of tags, causing the fill entity associated with the tag to be entered in the selected field in the form; and (d) repeating steps (a) through (c) until all of the fields in the form are filled and Figure 2 shows different fields which would contain different data.)



***Conclusion***

**5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

Karnik	U.S. Patent No. 5,404,294	issued	4/4/1995
Hirai et al.	U.S. Patent No. 5,450,537	issued	9/12/1995
Scharmer	U.S. Patent No. 5,640,577	issued	6/17/1997
Light et al.	U.S. Patent No. 6,192,380 B1	issued	2/20/2001
Gupta et al.	U.S. Patent No. 6,199,079 B1	issued	3/6/2001

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Londra C Burge whose telephone number is 703-305-8784. The examiner can normally be reached on 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Washington, DC 20231

**Or faxed to:**

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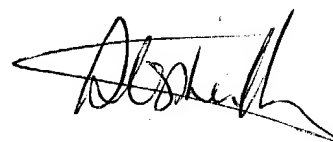
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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA, Fourth Floor (Receptionist).

Londra Burge  
7/28/04



**STEPHEN S. HONG**  
**PRIMARY EXAMINER**